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**FULL TEXT OF CASES (USPQ2D)**

All Other Cases

(Unpublished) In re Gold (ComrPats) 42 USPQ2d 1095 (12/31/1996)

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In re Gold

**U.S. Patent and Trademark Office Commissioner of Patents and  
Trademarks**

**42 USPQ2d 1095**

**Decided December 31, 1996**

**PLM Paper No. 18**

**Headnotes**

**PATENTS**

**1. Practice and procedure in Patent and Trademark Office -- Prosecution -- Rules and rules practice (§ 110.0905)**

**Patentability/Validity -- Anticipation -- Double patenting (§ 115.0708)**

Patent examiner is directed to withdraw requirement for restriction between claims in protein group and claims in antibody group in patent application, since Manual of Patent Examining Procedure's Section 803 states that restriction should not be required if there is express admission that claimed inventions are obvious over each other within meaning of 35 USC 103, since "patentable distinctness" issue between peptide and antibody groups in application is close, and since admission in present case, although it does not specifically mention 35 USC 103, states that antibody is obvious over peptide; absence of corresponding admission that peptide is obvious over antibody does not warrant contrary decision, in view of Patent and Trademark Office policy that "no restriction requirements be made which might result in the issuance of two patents for the same invention."

## Case History and Disposition:

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Patent application of Leslie I Gold. et al. On applicants' petition requesting that restriction requirement be withdrawn. Petition granted.

→ [Editor's Note: The U.S. Patent and Trademark Office has not designated this decision as prepared for publication. It is not binding precedent of the Commissioner of Patents and Trademarks.

### Attorneys:

Roger L. Browdy, of Browdy & Neimark, Washington, D.C., for petitioner.

## [Unpublished Opinion] Opinion Text

### Opinion By:

Lee, deputy director, patent examining group 1800.

**[Unpublished Opinion]** This is a decision on the petition under 37 CFR 1.181 and 37 CFR 1.144, filed November 4, 1996, to withdraw the restriction requirement with respect to Groups I/II and VI. Note, petitions from restriction requirements are properly considered under 37 CFR 1.144. Therefore, the petition is being treated as a petition under 37 CFR 1.144.

**[Unpublished Opinion]** On April 7, 1995, an Office action was mailed that required restriction between claims 1-9 and 13 (Group I), claims 10-12 (Group II), claims 14-15 (Group III), claim 16 (Group IV), claim 17 (Group V), claim 18 (Group VI), and claims 19 and 20 (Group VII). With an election of Group II, applicant was further required to elect one of two patentably distinct species of the invention. In response to the Office action, applicants timely filed a response on August 7, 1995 in which applicants canceled claims 14-17 drawn to Groups III, IV and V, elected Group I, claims 1-9 and 13, and traversed the restriction requirement insofar as the claims of Groups II, VI and VII were deemed to be independent and distinct from the elected invention. On November 28, 1995, an Office action was mailed which withdrew the requirement for restriction between Groups I/II and Groups VI and VII. In applicants' response filed May 28, 1996, a request for reconsideration of the requirement for restriction with respect to Groups VI and VII was made. On September 4, 1996, a final Office action was mailed which reaffirmed the requirement for restriction. The present petition was filed on November 4, 1996 requesting that the restriction requirement between Groups I and VI be withdrawn at least to the extent of considering claim 5 to be a linking claim so that claim 18 will be considered at the time that claim 5 is allowable.

**[Unpublished Opinion]** Petitioner asserts that applicants have conceded that if the protein of claim 5 (from Group I/II) is anticipated or obvious then the antibody of claim 18 (Group VI) would

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also be obvious as it would be obvious to make an antibody to any known peptide. Thus, petitioner contends that if a patent issues containing a claim drawn to the protein of claim 5, and a divisional application is filed resulting in the issuance of a claim of the scope of claim 18, two patents will have

issued drawn to inventions which are not patentably distinct. Absent 35 U.S.C. 121, a double-patenting rejection would have to be made on the antibody claim because it is admittedly obvious from the protein. Thus, petitioner concludes that the restriction requirement between Groups I/II and VI should be withdrawn.

**[Unpublished Opinion]** [1] As argued by petitioner, MPEP Section 803 is appropriate here where it states:

**[Unpublished Opinion]** If there is an express admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103, restriction should not be required, *In re Lee*, 199 USPQ 108 (Deputy Asst. Comm'r. For Pats. 1978).

**[Unpublished Opinion]** The decision in *In re Lee* was based not only on the presence of an admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103 but also on the fact that the issue of "patentable distinctness" between the two groups was close and the Office policy:

**[Unpublished Opinion]** [T]hat it is important from the standpoint of public interest that no restriction requirements be made which might result in the issuance of two patents for the same invention. The nullification of double patenting as a ground of rejection provided for in the third sentence of 35 U.S.C. 121 imposes a heavy burden on the Office to guard against erroneous requirements for restriction where the claims define essentially the same invention and which if acquiesced in, might result in more than one patent for essentially the same invention with attendant prolongation of patent monopoly.

**[Unpublished Opinion]** Here, the Office policy is the same as when *In re Lee* was decided and like in *In re Lee*, the "patentable distinctness" issue between the peptide of Group I/II and the antibody of Group VI is close. Lastly, while the admission in this case does not explicitly state that the antibody is obvious over the peptide "within the meaning of 35 U.S.C. 103", the admission certainly implies this and that is how the admission is hereby interpreted. Therefore, like *In re Lee*, it is concluded that the public interest is better served by withdrawing the restriction requirement and permitting both inventions to be prosecuted in the same application. At this point it is noted that the fact that there is an admission that the antibody is obvious in view of the peptide but not an admission that the peptide is obvious over the antibody would not change this decision because the Office policy that "no restriction requirements be made which might result in the issuance of two patents for the same invention" would still control.

**[Unpublished Opinion]** In conclusion, the petition is granted and the examiner is directed to withdraw the requirement for restriction between Groups I/II and VI. Group VII remains restricted from Groups I/II/VI. The application is being returned to the examiner for appropriate action in a timely manner.

**[Unpublished Opinion]** PETITION GRANTED.

- End of Case -

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